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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,101	02/23/2001	Isabelle Rollat-Corvol	05725.0807	4969

7590

01/08/2003

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EXAMINER

WILLIS, MICHAEL A

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 01/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,101

Applicant(s)

ROLLAT-CORVOL ET AL.

Examiner

Michael A. Willis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-106 is/are pending in the application.
- 4a) Of the above claim(s) 59, 61-68, 70-77, 80-82 and 85-87 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-58, 60, 69, 78, 79, 83, 84 and 88-106 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Applicant's response of 30 October 2002 is entered. No amendments to the claims are made. Claims 38-106 are pending. Any previous rejections that are not restated in this Office Action are hereby withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

Applicant's election with traverse of branched sulfonic polyesters as the species of tacky polymer and octylacrylamide/acrylate/butylaminoethyl/methacrylate polymer as the species of fixing polymer in Paper No. 10 is acknowledged. As indicated previously, claims 59, 61-68, 70-77, 80-82, and 85-87 are withdrawn from consideration as directed to non-elected subject matter. Claims 38-58, 60, 69, 78-79, 83-84, and 88-106 are examined as they read on the elected species.

Response to Arguments

Claims 38-58, 60, 69, 78-79, 83-84, and 88-106 are rejected under 35 USC 102(b) as anticipated by Lee et al (EP 0 551 749 A2) and under 35 USC 103(a) as being unpatentable over Lee et al (EP 0 551 749 A2) for reasons as stated previously.

Applicant argues that Eastman AQ polymers as disclosed by Lee do not meet the limitation of a tacky polymer of the instant application. Applicant argues that Lee teaches Eastman AQ polymers should have "a glass transition temperature ranging from about 50° C to about 70° C, preferably about 55° C". However, applicant's

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characterization of Lee's teachings is incomplete. Lee actually discloses a broader range of polymers. Lee discloses that "most preferred are polyesters functionalized with a sulpho (SO_3^-) group in amounts sufficient to water-disperse the polyester" (see page 3, lines 15-16). Lee further discloses that "Illustrative of such resins are Eastman AQ Polymers" (see page 3, line 17). The polymers with Tg from about 50° C to about 70° C, preferably about 55° C, are merely the most preferred species of Eastman AQ polymers. It has been established that disclosed examples and preferred embodiments do not constitute a teaching which is away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

In response to the inherency argument presented by the Examiner, Applicant further argues that ethylene diglycol/cyclohexanedimethanol/isophthalates/sulphoisophthalates resin is Eastman AQ 55S with a Tg of 55° C by reference to an attached product information brochure from Eastman. Applicant's arguments are not convincing, as follows. First of all, the product information brochure from Eastman cannot be properly considered, as it is not listed on an Information Disclosure Statement, Form 1449. Secondly, while the brochure does provide evidence that Eastman AQ 55S has a Tg of 55° C, the brochure does not provide evidence that Eastman AQ 55S is ethylene diglycol/cyclohexanedimethanol/isophthalates/sulphoisophthalates resin, nor does the brochure provide evidence that all such

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multicomponent resins have a Tg of 55° C. Finally, it is noted that the disclosure of Lee is directed to Eastman AQ polymers. While the Examiner concedes that Eastman AQ 55S has a Tg of 55° C, other Eastman AQ polymers have lower Tg. For example, in the Eastman AQ Branched Polyester brochure previously submitted by applicant, it is clearly shown that Eastman AQ 1045, AQ 1350, AQ 1950, and AQ 14000 each have Tg of less than 20°C. Therefore, the fact that Lee discloses Eastman AQ polymers that overlap with applicant's claims renders the instant claims unpatentable.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

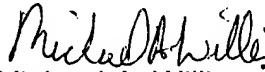
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-

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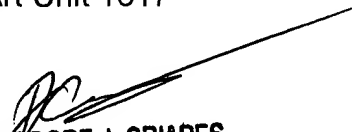
1679. The examiner can normally be reached on alt. Mondays and Tuesday to Friday (9am-6:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703) 305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.


Michael A. Willis
Examiner
Art Unit 1617

maw
January 6, 2003


THEODORE J. CRIARES
PRIMARY EXAMINER
GROUP 12006 02